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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,410	01/23/2002	Michael Van Abel	P/73-6	1619

7590

10/19/2004

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EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/057,410

Applicant(s)

ABEL ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/26/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 May 2004 has been entered. Claims 1, 3, 6-8 and 10 are pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

3. In light of the applicant's amendment, the rejection of claims 1 and 3 under 35 U.S.C. 102(b) are hereby withdrawn.

### ***Claim Rejections - 35 USC § 103***

4. Claims 1, 3, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaperot et al (EP 0 831 032 A1).

Regarding claim 1, Chaperot et al discloses a ream wrap (Figures 1-3) comprising a paper poly coated composite (1) having transparent, solid plastic film

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windows (3, 4, 9, 10). Chaperot et al teaches the window on both sides of a joining edge of the ream (see Figure 3).

Chaperot et al lacks, or does not expressly disclose a window allowing the viewing of the face of the paper contained within the ream.

Chaperot et al teaches the window location when the reams are stacked in a certain manner (PTO translation, page 2, 1<sup>st</sup> paragraph). One of ordinary skill in the art would have recognized that if the reams are stored or displayed in a different orientation, then the window location should be changed to enable viewing of the contents. It would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the window such that the window allows viewing of the face of the ream in order to enable stacking in a different orientation. It has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

As to claim 3, Chaperot et al (as modified above) discloses windows cut into the top and side of the ream wrap.

Regarding claim 7, Chaperot et al discloses a first layer of paper (1) and a second layer of transparent film (9, 10), and holes (3, 4) cut out of both sides of a joining edge and allowing viewing of multiple sheets of paper contained in the ream.

Chaperot et al lacks, or does not expressly disclose a window allowing the viewing of the face of the paper contained within the ream.

Chaperot et al teaches the window location when the reams are stacked in a certain manner (PTO translation, page 2, 1<sup>st</sup> paragraph). One of ordinary skill in the art

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would have recognized that if the reams are stored or displayed in a different orientation, then the window location should be changed to enable viewing of the contents. It would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the window such that the window allows viewing of the face of the ream in order to enable stacking in a different orientation. It has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Chaperot et al does not expressly disclose an adhesive. The examiner takes Official Notice that the use of an adhesive to apply a film to a sheet was common and conventional at the time the invention was made and the use of such an adhesive to secure the film to the ream wrap would have been obvious to ensure that the film remained in place.

Applicant, of course, has the right to challenge this Official Notice in response to this decision and demand production of evidence in support thereof, provided such challenge is accompanied by adequate information or argument that, on its face, creates a reasonable doubt regarding the circumstances justifying the Official Notice.

See In Re Boon, 439 F.2d 724, 169 USPQ 231, 234 (CCPA 1971).

5. Claims 6, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaperot et al in view of Gatewood et al (US 2002/0050119 A1).

Regarding claim 10, Chaperot et al, as applied to claim 1 above, discloses the claimed invention except for the film covering the entire paper material.

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Gatewood et al discloses a clear film laminated to a paper backing in order to increase the strength of the wrap (see for example paragraphs [0030] and [0034]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the film of Chaperot et al cover the entire paper material as taught by Gatewood et al in order to increase the strength of the wrap.

As to claim 8, the wrap of Chaperot-Gatewood, as applied to claim 10 above, discloses the claimed invention, including the claimed basis weight (see Gatewood et al, paragraph [0029]).

As to claim 6, the wrap of Chaperot-Gatewood, as applied to claim 10 above, discloses the claimed method by presentation.

### ***Response to Arguments***

6. Applicant's arguments filed 3 May 2004 have been fully considered but they are not persuasive.

7. Applicant's arguments concerning the term "top" with respect to the glass example are irrelevant since the shapes and functions of the glass and claimed structure are completely different.

8. The examiner disagrees with the applicant's assertion that Chaperot et al teaches against the inspection window showing the face of the retained paper. As noted above, the usefulness of this location is only considered reduced when the reams

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are stacked in a certain manner. If the reams are stored or displayed in a different manner, then one of ordinary skill in the art would have recognized that the window would need to be relocated.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation can be found in Gatewood paragraphs [0030] and [0034].

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*GP*  
Greg Pickett  
Examiner  
16 October 2004

  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700